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09/401,004	09/21/1999	HENGYUAN LANG	P-HP-3589	4060

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EXAMINER

BAKER, MAURIE GARCIA

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 05/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. 09/401,004	Applicant(s) Lang et al
Examiner Maurie G. Baker, Ph.D.	Art Unit 1639



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Feb 12, 2003

2a)  This action is **FINAL**. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 17-36 and 38-48 is/are pending in the application.

4a)  Of the above, claim(s) 23, 24, 27-34, 41, and 46-48 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 17-22, 25, 35, 36, 38-40, and 42-45 is/are rejected.

7)  Claim(s) 26 is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

## DETAILED ACTION

**Please note:** The number of Art Unit 1627 has been changed to 1639. Please direct all correspondence for this case to **Art Unit 1639**.

1. The Responses filed September 24, 2002 (Paper No. 22) and February 12, 2003 (Paper No. 26) are acknowledged. In Paper No. 22 claims 17-25 were amended, claims 42-48 were added and claims 16 and 37 were cancelled. Therefore, claims 17-36 and 38-48 are pending.

### *Election/Restriction*

2. Claims 23, 24, 27-30 and 41 remain withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected species, the requirement having been traversed in Paper No. 14. Newly added claims 46 and 47 do not read on the elected species and are also withdrawn. Also please note MPEP § 803.02 (emphasis added) with respect to species elections and Final Office Actions:

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. *Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.*

3. Applicant has requested that claims 31-34 and newly added 48 directed to methods of making single compounds be rejoined with the product claims as per MPEP 821.04. However, this provision only takes effect when the product claim is found to be allowable. The product claims are not currently deemed to be allowable. Note rejoinder is only appropriate when the scope of the product and process claims is identical; note the following:

Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims directed to the process of making or using a patentable product, previously withdrawn from consideration as a result of a restriction requirement would be subject to being rejoined at such time as the product becomes allowable. Note that process claims which do not depend from or otherwise include *all the limitations of the allowable product* will not be subject to being rejoined.

Therefore, claims 31-34 and newly added 48 remain withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions.

4. Newly added claims 42-45 read on the elected species and are included in the examination. Thus, claims 17-22, 25, 26, 35, 36, 38-40 and 42-45 are examined on the merits in this action.

#### *Status of Rejections*

5. The rejections under 35 U.S.C. 102 over Kenney et al and Miyachi et al are withdrawn in view of applicant's claim amendments. The rejection under 35 U.S.C. 112, second paragraph is also withdrawn, in light of applicant's arguments.

***Maintained Rejections***  
***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(e) of this title before the invention thereof by the applicant for patent.

7. Claims 17-22, 25, 35, 36, 38-40 and 42-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Girten et al (US 6,284,735).

Girten et al disclose compounds that read directly on those claimed. See Compounds A to D as disclosed in columns 8 (beginning on line 37) through 9 where four compounds reading on those of the claims are specifically shown. These compounds read on the instant claims when R<sup>1</sup>, R<sup>2</sup> and R<sup>4</sup> of the claims are H; R<sup>6</sup> = substituted methylene (D = substituted alkylene and W & E absent; substituents are substituted alkyl); and R<sup>7</sup> and R<sup>8</sup> are H. The compounds of Girten et al read on the instant R<sup>3</sup> group when it is -(C)ONR<sup>11</sup>R<sup>12</sup>, with R<sup>11</sup> and R<sup>12</sup> = H and/or substituted alkyl (substituents are phenyl). Furthermore, these compounds are substituted at the instant R<sup>5</sup> position with substituted phenyl groups, reading on the instant claims.

***Response to Arguments***

8. Applicant's arguments filed September 24, 2002 have been fully considered but are not found persuasive. The examiner's rationale is set forth below.

9. Applicant argues that the Declaration under 37 CFR 1.131 filed September 24, 2002 is sufficient to antedate the Girten et al reference. The examiner respectfully disagrees for the following two reasons.

(1) The Declaration filed under 37 CFR 1.131 is deficient because all inventors must sign a 1.131 Declaration, not just a single member of the inventive entity. Furthermore, the rule requires an averment that the invention was made in the United States, a NAFTA country or a WTO country.

(2) Importantly, MPEP 715.03 Section B. should be considered as the Girten et al reference discloses several species that read on the claimed genus. The principle is well established that the disclosure of a species in a cited reference is sufficient to prevent a later applicant from obtaining a “generic claim.” *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989); *In re Slayter*, 276 F.2d 408, 125 USPQ 345 (CCPA 1960). A reference or activity which discloses several species of a claimed genus can be overcome directly under 37 CFR 1.131 only by a showing that the applicant completed, prior to the date of the reference or activity, all of the species shown in the reference. *In re Stempel*, 241 F.2d 755, 113 USPQ 77 (CCPA 1957). As this has not been done, the Declaration filed under 37 CFR 1.131 is deficient in its showing.

*Status of Claims/Conclusion*

10. No claims are allowed. However, claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner is on an increased flextime schedule but can normally be reached on Monday-Thursday and alternate Fridays from 9:30 to 7:00.

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13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached at (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.  
May 14, 2003



MAURIE GARCIA BAKER, PH.D.  
PRIMARY EXAMINER